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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,578	07/26/2000	TADASHI KURIYAMA	106336	9483

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/31/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,578

Applicant(s)

KURIYAMA ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 1 is objected to for the phrase, "wherein said adhesive layer comprising a hot water-soluble...." The examiner suggests replacing "comprising" with "comprises" to facilitate clarity. Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrases, "normal temperature" and "hot water" are indefinite. It is unclear what temperature of water constitutes "normal" and what temperature constitutes "hot." Furthermore, the phrase, "easy to dissolve" in claim 1 is indefinite. It is unclear what constitutes something being "easy to dissolve." Proper clarification and/or correction are required.
5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The phrase, "said tack label is not easily peeled" is indefinite. It is unclear to what degree of

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peeling constitutes something being “easily peeled.” Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 7-9, and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lowman (GB 2,259,291 A).

Lowman discloses a plastic container (Fig. 1, #10) with a tack label comprising a label base material (p.4, lines 7-9), a printing layer formed on a first surface of the base material (p.2, lines 10-12), and an adhesive layer formed on a second surface which opposes the first surface of the label base material (p.1, line 24 to p.2, line 2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract; p.2, lines 20-26; p.3, lines 12-15). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract). The adhesive layer comprises an acrylic water-soluble adhesive (p.2, lines 23-26) and the base label material comprises a material (paper) whose specific gravity is less than one (p.2, lines 17-19; see Also *On the Distribution of Mass, Thickness, and Density in Paper*, Fig. 2, page 4, for verification of the density of paper (0.4-0.85 g/cm³)). Although Lowman does not explicitly

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state that the tack label is peeled from a container body within 30 minutes when the container body is submersed in 75 degrees Celsius hot water and that the tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40 degrees Celsius water, the aforementioned limitation is inherently met since Lowman discloses the same adhesive material composition as the claimed invention, therefore rendering the material properties inherently consistent.

8. Claims 1 and 8-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dudzik et al. (#4,444,839).

Dudzik et al. disclose a plastic container (Col. 1, lines 19-22) with a tack label comprising a label base material (Fig. 1, #1), a printing layer formed on a first surface of the base material (Fig. 1, #4), and an adhesive layer formed on a second surface which opposes the first surface of the label base material (Fig. 1, #2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract; Col. 1, lines 36-39). Although Dudzik et al. do not explicitly state that the tack label is peeled from a container body within 30 minutes when the container body is submersed in 75 degrees Celsius hot water and that the tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40 degrees Celsius water, the aforementioned limitation is inherently met since Lowman discloses equivalent testing methods proving the limitation (Col. 3, lines 45-52; Col. 4, lines 16-21; Col. 4, lines 40-45; Col. 4, lines 61-67).

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9. Claims 1 and 8-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Taki (EP 0 326 039 A1).

Taki disclose a plastic container (Col. 1, lines 32-33) with a tack label comprising a label base material (Col. 3, lines 12-13), a printing layer formed on a first surface of the base material (Col. 1, line 55 to Col. 2, line 2), and an adhesive layer formed on a second surface which opposes the first surface of the label base material (Col. 3, lines 14-19), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (Col. 3, lines 14-19). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (Col. 10, lines 23-35). Although Taki does not explicitly state that the tack label is peeled from a container body within 30 minutes when the container body is submersed in 75 degrees Celsius hot water and that the tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40 degrees Celsius water, the aforementioned limitation is inherently met given that the hot-water soluble adhesive is not soluble unless in contact with water warmer than 50 to 70 degrees Celsius (Col. 3, lines 16-19).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taki (EP '039) in view of *Specific Gravity of Major Polymers*.

Taki teaches a plastic container with a tack label as detailed above. Although Taki does not explicitly state that the base material comprises a material whose specific gravity is less than one, Taki teaches that the label blank is made of any known film of plastics which may be either thermally shrinkable or stretchable (Col. 6, lines 39-41). Therefore, since any known plastic film would be selected for the base material of the tack label, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have selected a known plastic such as polyethylene, polypropylene, or polybutylene with known specific gravities less than 1 (evidenced by *Specific Gravity of Major Polymers*, <http://www.plasticusa.com/specgrav.html>) such that when the label is submersed in hot water, the label floats to the top of the hot water bath when separated from the bottle.

12. Claims 3, 5-6, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowman (GB '291) in view of Vines et al. (#5,631,055).

Lowman teaches a plastic container with a tack label as detailed above. Lowman fails to teach the use of a masking layer that is situated in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer wherein a masking layer may also be placed on a portion of the edge of the adhesive layer.

Vines et al. however, teach the use of a masking layer that is in both the central part (Fig. 1, #18) and the edge region (Fig. 3, #28) of the adhesive layer thereby forming a ring of adhesive about the masking layer (Fig. 6, #43). Although Vines et al. do not explicitly state that 5-90% of the adhesive layer is covered by the masking layer, the masking layer is sectionalized into three

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portions (Fig. 2, #s 16 and 18) thereby allowing each portion to be removed and ultimately allowing from 0-100% of the adhesive layer to be masked. Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have covered a specific proportion of the adhesive area, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Vines et al. teach the use of the masking layer for the purpose of allowing the sheet to be releasably adhered to a substrate (Col. 2, lines 23-27). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a tack label to comprise a masking layer for the purpose of allowing the label to be releasably adhered to a substrate as taught by Vines et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Lowman to include a masking layer on the adhesive backing as taught by Vines et al. in order to allow the label to be releasably adhered to the bottle.

13. Claims 3, 5-6, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowman (GB '291) in view of Aoyagi (#4,032,679).

Lowman teaches a plastic container with a tack label as detailed above. Lowman fails to teach the use of a masking layer that is situated in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer wherein a masking layer may also be placed on a portion of the edge of the adhesive layer.

Aoyagi, however, teaches the use of a masking layer that is in both the central part (Fig. 2, #23b) and the edge region (Fig. 2, #23) of the adhesive layer thereby forming a ring of adhesive about the masking layer (Fig. 1). Although Aoyagi does not explicitly state that 5-90% of the adhesive layer is covered by the masking layer, the masking layer is sectionalized into five portions (see Figs. 2-3) thereby allowing each portion to be removed and ultimately allowing from 0-100% of the adhesive layer to be masked. Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have covered a specific proportion of the adhesive area, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Aoyagi teaches the use of the masking layer for the purpose of allowing the label to be easily detached from a substrate (Col. 1, lines 45-47). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a tack label to comprise a masking layer for the purpose of allowing the label to be easily detached from a substrate as taught by Aoyagi.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Lowman to include a masking layer on the adhesive backing as taught by Aoyagi in order to allow the label to be easily detached from the bottle.

14. Claims 3, 5-6, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. ('839) in view of Vines et al. ('055).

Dudzik et al. teach a plastic container with a tack label as detailed above. Although Dudzik et al. teach the use of a masking layer (Fig. 1, #3), Dudzik et al. fail to teach the masking

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layer being cut such that a portion of the masking layer remains on the central or outside portions of the adhesive layer when applying the label to the bottle.

Vines et al. however, teach the use of a masking layer that is in both the central part (Fig. 1, #18) and the edge region (Fig. 3, #28) of the adhesive layer thereby forming a ring of adhesive about the masking layer (Fig. 6, #43) after removing a scored portion of the masking layer (see Fig. 1). Although Vines et al. do not explicitly state that 5-90% of the adhesive layer is covered by the masking layer, the masking layer is sectionalized into three portions (Fig. 2, #s 16 and 18) thereby allowing each portion to be removed and ultimately allowing from 0-100% of the adhesive layer to be masked. Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have covered a specific proportion of the adhesive area, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Vines et al. teach the use of the masking layer for the purpose of allowing the sheet to be releasably adhered to a substrate (Col. 2, lines 23-27). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a tack label to comprise a masking layer for the purpose of allowing the label to be releasably adhered to a substrate as taught by Vines et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Dudzik et al. to include score lines on the masking layer on the adhesive backing as taught by Vines et al. in order to allow a portion of the masking layer to remain on the adhesive backing thereby allowing the label to be releasably adhered to the bottle.

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15. Claims 3, 5-6, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. ('839) in view of Aoyagi ('679).

Dudzik et al. teach a plastic container with a tack label as detailed above. Although Dudzik et al. teach the use of a masking layer (Fig. 1, #3), Dudzik et al. fail to teach the masking layer being cut such that a portion of the masking layer remains on the central or outside portions of the adhesive layer when applying the label to the bottle.

Aoyagi, however, teaches the use of a masking layer that is in both the central part (Fig. 2, #23b) and the edge region (Fig. 2, #23) of the adhesive layer thereby forming a ring of adhesive about the masking layer (Fig. 1) after portions of the scored masking layer are removed (see Fig. 3). Although Aoyagi does not explicitly state that 5-90% of the adhesive layer is covered by the masking layer, the masking layer is sectionalized into five portions (see Figs. 2-3) thereby allowing each portion to be removed and ultimately allowing from 0-100% of the adhesive layer to be masked. Furthermore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have covered a specific proportion of the adhesive area, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). Aoyagi teaches the use of the masking layer for the purpose of allowing the label to be easily detached from a substrate (Col. 1, lines 45-47). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a tack label to comprise a masking layer for the purpose of allowing the label to be easily detached from a substrate as taught by Aoyagi.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified Dudzik et al. to include a scored masking layer on the adhesive backing as taught by Aoyagi in order to allow a portion of the masking layer to remain on the adhesive layer thereby allowing the label to be easily detached from the bottle.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
July 29, 2002


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 7/29/02